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1714

Date: October 22, 2002 Label No. EV178735458US

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Dawn M. Berry
Name (Print)

Dawn M. Berry
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

)

MAHMUD et al.

)

Application No.: 09/975,699

)

Group Art Unit: 1714

Filed: October 11, 2001

)

Examiner: P. SZEKELY

For: A METHOD OF MAKING A MULTI-PHASE AGGREGATE
USING MULTI-STAGE PROCESS

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Assistant Commissioner for Patents
Washington, D.C. 20231

October 22, 2002

Sir:

This Response to Restriction Requirement and Election of Species is in response to the Office Action dated September 24, 2002, for which the Examiner has set a one-month period for response, thus making the response due on or before October 24, 2002.

In the Office Action, the Examiner requires applicants to elect an invention selected from Group I directed to an aggregate encompassing claims 59-81 and 95-117 or Group II drawn to an elastomeric composition encompassing claims 82-94 and 118-130.

The Examiner asserts that the inventions are distinct.

Applicants respectfully traverse the restriction requirement since it is believed that there would be no serious burden on the Examiner to search the subject matter of Groups I and II at the same time. The applicants note that claims of Group II are dependent on the claims of Group I. Therefore, while applicants appreciate the different classes and subclasses, it appears that there will be significant overlapping in the search conducted by the Examiner and thus it would be logical to search both groups at the same time. As set forth in M.P.E.P. § 803, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though the application includes claims to two distinct or independent inventions. The

Response To Restriction Requirement And Election Of Species
U.S. Patent Application No. 09/975,699

Applicants contend that a serious burden does not exist for the Examiner to examine the subject matter of Group I and Group II. Since claims 82-94 and 118-130 relate to having at least one elastomer with the aggregate set forth in claim 59, it is not understood how an undue burden would exist with the Examiner searching the subject matter of claims 82-94 and 118-130. Accordingly, the Examiner is requested to reconsider his decision and to remove the restriction and election of species requirement.

To be responsive to this Office Action, the applicants elect with traverse the subject matter of Group I encompassing claims 59-81 and 95-117.

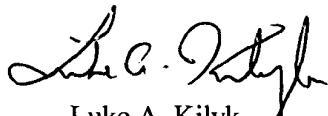
At page 3 of the Office Action, the Examiner has also detailed an election of species requirement and is now requiring applicants to elect a single disclosed species for prosecution on the merits. For the following reasons, this election of species requirement is also respectfully traversed.

To be responsive to the Examiner, the applicants elect with traverse the species of an aggregate having a silanol group(s) at the surface.

Claims 59-81 and 95-117 read on this elected species. The Examiner is respectfully requested to examine the genus of the elected invention as opposed to the elected species.

In the event any fees are required in connection with this response, please charge Deposit Account No. 03-0060.

Respectfully submitted,



Luke A. Kilyk
Reg. No. 33,251

Atty. Docket No. 97020CIP2CON3(3600-091-04)
KILYK & BOWERSOX, P.L.L.C.
53 A East Lee Street
Warrenton, VA 20186
Tel: (540) 428-1701
Fax.: (540) 428-1720